

**REMARKS**

***I. STATUS OF THE CLAIMS***

Claims 13 and 22 have been canceled. New claims 25-27 have been added. New claims 25 and 26 find support, for example, in claims 13 and 22 as originally filed and do not contain the “use” format of claims 13 and 22. New claim 27 finds support, for example, in Figure 1, in Example 3 and throughout the specification. No new matter has been added by any of these amendments.

***II. PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION***

Claims 9-12, 14, 15, 18-21, 23 and 24 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,376,657.

In order to expedite the prosecution of this application to allowance, a Terminal Disclaimer relative to U.S. Patent No. 6,376,657 has been filed herewith, thereby overcoming this ground for rejection.

Claims 15 and 24 have been similarly rejected over claims 122 and 130 of commonly assigned copending Application No. 10/170,750, which are directed toward a method of suppressing appetite in a human or animal by administering a suitable dosage of an extract obtained from a plant of the genus *Trichocaulon* or the genus *Hoodia*.

Applicants believe that claims 122 and 130 in copending Application No. 10/170,750 are in a condition for allowance. Therefore, Applicants hereby state that once claims 122 and 130 have been indicated as allowed, then claims 15 and 24 in this application will be canceled. Cancellation of claims 15 and 24 would effectively moot this ground for rejection.

***III. THE REJECTION UNDER 35 U.S.C. § 101***

Use claims 13 and 22 have been rejected under 35 U.S.C. § 101 because, according to the Examiner, they do not recite any steps and the claimed recitation of a

use, without setting forth any steps involved in the process, results in an improper definition of a process.

Applicants have canceled claims 13 and 22, without prejudice or waiver of the subject matter thereof, as being in a “use” format not generally acceptable in U.S. patent practice.

#### **IV. THE REJECTION UNDER 35 U.S.C. § 103(a)**

Claims 1-8, 16, 17 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Chem. Pharm. Sci. Bull. 30(10), 3500-4 (1982) to Wada *et al.* (“Wada”) in view of Bot. Jahrb. Syst. 115(2), 145-270 (1993) to Bruyns (“Bruyns”).

Specifically, the Examiner alleges that *Wada* teaches a method of extraction of a plant of the genus *Asclepiadaceae* and discloses the process steps of treating plant material with chloroform and methanol, separating the extraction solution from the rest of the plant material, further extraction of the methanol-soluble portion with hexane and a hexane/benzene solvent mixture and removing the solvent from the extraction solution and recovering the extract. In addition, the Examiner states that *Wada* discloses the use of chromatographic separation of the active agent in the extracted material on page 3503 of the Experimental section. The Examiner combines the teaching of *Wada* with the teaching of *Bruyns*, which, the Examiner alleges, discloses the medical use of the plants of the genus *Trichocaulon* and *Hoodia* as appetite suppressant and thirst quenching agents. According to the Examiner, one of ordinary skill in the art would have found Applicants’ claimed process for preparing an extract of a plant of the genus *Trichocaulon* or of the genus *Hoodia*, having appetite suppressant activity, to have been obvious in light of *Wada* and *Bruyns*.

Applicants respectfully disagree with the Examiner’s assessment of *Bruyns* and its combination with *Wada* to allegedly make Applicants’ invention obvious. *Wada* simply describes the isolation of two novel oligoglycosides from a rhizome of the *Asclepiadaceae* family because the oligoglycosides are purported to exhibit “immunopotential activities” (page 3500). The nature of these immunopotential activities is not defined in *Wada*. As such, there is no teaching or suggestion in *Wada*

that extracts of plants of the genus *Hoodia* or of the genus *Trichocaulon* possess appetite suppressant activity. *Bruyns* merely teaches that the stems of certain species of plants of the genus *Hoodia* can be cut into strips and that the strips can be eaten.

In particular, *Bruyns* discloses that these strips “have a peculiar pervasively spreading sweet taste which is remarkably persistent and is said to quench thirst and hunger for extended periods” (page 175). Webster’s Unabridged Dictionary (2<sup>nd</sup> Edition, ISBN 0-671-41819-X) defines the word “quench” as meaning to “to extinguish; to put down, to satisfy or to cool suddenly” something that is burning or hot. The word “quench” has no hidden meaning of or connotation to either “prevention” or “suppression.” Thus, *Bruyns* teaches no more than that the eating of strips (“or extracts”) from *Hoodia* will still thirst and hunger. No suppressive effect is therefore described or taught.

A reading of *Bruyns* does not allow appetite suppressant activity to be distinguished from, for example, the simple hunger and thirst alleviating properties of any juicy, sweet plant material with a high liquid and sugar content. The identification and characterization of appetite suppressing activity requires the isolation of an extract or compound and the activity must be determined independently from the nutritious edible parts of the plant that may quench thirst or hunger. Because *Bruyns* clearly does not identify any potential appetite suppressant properties associated with the disclosed plant strips, a person skilled in the art would not be motivated to combine *Bruyns* with *Wada* to achieve Applicants’ invention.

Applicants’ claims carry the requirement that the extracted material has activity in suppressing appetite or combating obesity. There is no teaching in *Bruyns* that any extract of *Hoodia* plants will suppress appetite or combat obesity. “Extract” implies that only a portion of the plant material has been separated from the remainder of the plant. *Bruyns* contains no teaching or suggestion as to which part of the plant mass is physiologically active and so there can be no teaching that an extract has any physiological effect even if it is known that the cut-up stems exhibit some physiological activity. The physiologically active portion of the plant may well be part of what remains when the extract is obtained. As such, *Bruyns* does not meet the minimal requirements of

a credible teaching of a physiological effect of *Hoodia* plant material with regard to a appetite suppressant. Because *Bruyns* does not remedy the inadequacies previously discussed in *Wada*, Applicants respectfully request that this rejection of claims 1-8, 16 and 17 under 35 U.S.C. § 103(a) be withdrawn.

**V.     *OBJECTION TO THE DRAWINGS***

In response to the objection raised regarding the margins of Figures 1-4, Applicants submit herewith corrected Figures 1-6.

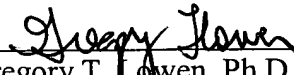
**VI.    *CONCLUSION***

Applicants respectfully request reconsideration of the subject application in view of the above amendments and remarks. The subject application is now in condition for allowance and early notice to that effect is respectfully solicited. Should the Examiner feel that there are any issues outstanding after consideration of this amendment, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTION PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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